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On Dec. 21, 2001 by Kay Bailey Kay Bailey
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Markl, Isabel et al.

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Serial No.: 09/699,243

FEB 05 2002

Filed: 27 October 2000

TECH CENTER 1600/2900

For: METHYLATION ALTERED DNA SEQUENCES AS MARKERS
ASSOCIATED WITH HUMAN CANCER

Examiner: Jeanine A. Enewold Goldberg

Art Unit: 1655

Docket No.: 47675-14

Date: 21 December 2001

Box Non Fee Amendment
Assistant Commissioner for Patents
Washington, DC 20231

RESPONSE TO RESTRICTION REQUIREMENT

Sir or Madam:

This is in response to a Restriction Requirement dated 21 September 2001, and to a Telephonic Interview summary dated 29 October 2001, for the above-identified patent application. Kindly extend the time for response two months, up to and including 21 December 2001. A request for a two-month extension of time is provided.

REMARKS

Applicants, in the telephonic interview of 26 October 2001, respectfully traversed Examiner's imposed restriction requirement as between Examiner's proposed Groups I (claims 1-6) and II (claims 7-12) based on the argument that the kits of Group II had no likely use other than in the diagnostic assays of Group I.

Applicants thank the Examiner for rejoining these two groups according to the telephonic interview summary, dated 29 October 2001.

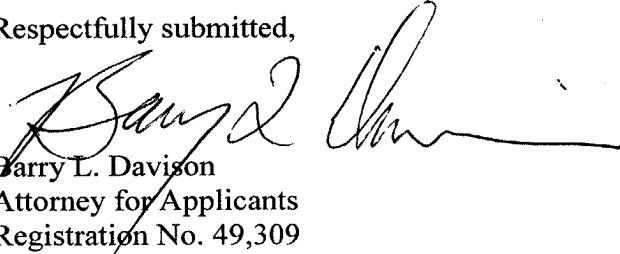
Applicants, in the telephonic interview of 26 October 2001, also respectfully traversed Examiner's imposed restriction requirement as among applicant's disclosed 103 individual and distinct nucleotide sequences in alternative form. Applicants argued that the need to file 102 divisional applications was unduly burdensome where as here, the DNA sequences, while individual and distinct, share a common core feature that is essential to the claimed invention; namely, the presence in each of at least one CpG dinucleotide sequence that is differentially methylated in cancer versus normal tissues.

The Examiner, while not accepting applicants' quasi-genus argument, agreed, at least in the instant case, to examine "up to five sequences" for purposes of pending claims 1-12. We thank the Examiner, and understand that if the Examiner finds the instant search and consideration of five sequences to be unduly burdensome, then applicants "may be required to elect a single sequence in divisional cases."

Accordingly, applicants elect, with traverse (based on the presence of a shared common essential core element), SEQ ID NOs:34-38, corresponding to sequences having at least one CpG dinucleotide sequence that is differentially methylated in prostate cancer.

Applicants respectfully request examination and consideration of claims 1-12, for SEQ ID NOs:34-38.

Respectfully submitted,



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